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10/086,406	03/01/2002	Terry H. Beck	W3688 1010.1	1280
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/086,406

Applicant(s)

BECK ET AL.

Examiner

HARISH T. DASS

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-156 is/are pending in the application.
- 4a) Of the above claim(s) 27-80 and 106-152 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 81-105 and 153-156 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to Applicant's communication of 3/9/2009.

2. ***Status of claims:***

Claims 1-26, 81-105 and 153-156 are pending (claims 2-11 and 82-91 have been added as courtesies – see below).

Claims 27-80 and 106-152 are withdrawn.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26, 81-105 remain rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). The process steps in claims (1-26, 81-105) are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

NOTE:

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for

example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine.

The mere recitation of the machine with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. **Insignificant extra-solution activity will not transform an unpatentable principle into a patentable process** (see John Love, Deputy Commissioner for Patent Examination Policy, memorandum Jan. 7, 2009).

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al-
http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=

Q

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26, 81-105 and 153-156 rejected under 35 U.S.C. 103(a) as being unpatentable over Vicknair et al. (hereinafter Vicknair - US 2003/0208421 A1) in view of Bellinger et al. (hereinafter Bellinger - US 5,870,725).

Re. Claim 1, Vicknair discloses receiving at a first time a plurality of electronically presented items, wherein one or more of the items received is comprised of a source key and transaction data associated with the source key (key or ISN) [see entire document which is relevant to particularly, Abstract; Figures 1-2; paragraphs 8, 15-20 (ECP); claim 6 (key)];

for each item received at the first time, assigning an electronic item presentment (EIP) sequence number to the item, associating the item's transaction data with the item's EIP sequence number, and associating the item's EIP sequence number with the item's source key [paragraphs 37-38 (ISN)];

receiving at a second time image data **in a digitized format** for one or more of the items received the first time, wherein the image data for each item received at the second time is associated with the item's source key [paragraphs 31, 34 – see **digital image which means in digital format**]; and

for each item received at the second time, associating the item's image sequence number with the item's EIP sequence number by matching (i) the source key associated with the item's EIP sequence number received at the first time with (ii) the source key associated with the item's image sequence number received at the second time [paragraphs 11; claim 1], **wherein the matching step is performed by an electronic item presentment computer [inherent - see**

paragraphs 08, 41 “electronic database”, and “ECP processing ... computer files” which means the process is done by computer].

Vicknair *does not explicitly disclose* for each item received at the second time, assigning an image sequence number to the item, associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key **to preserve a linkage integrity between the item and the item's image data.**

However, Rational database such as: IBM DBII, Oracle 8i, MySQL, Sybase, etc are well-known and used for assigning a primary key, secondary key, indexing, correlating the records, etc.

Bellinger discloses for each item received at the second time, assigning an image sequence number to the item (image identification key), associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key (MICR data) and **to preserve a linkage integrity between the item and the item's image data** [Figures 5, 20-22; col. 6 lines 15-25, col. 12 lines 14-20; col. 15 lines 1-4; col. 5 lines 5-12, col. 19 lines 40-44 (cross reference obviously preserves the linkage integrity between related data)] and further Bellinger also discloses **matching step is performed by an electronic item presentment computer (computer)** [col. 14 lines 9-41].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Vicknair and include for each item received at the second time, assigning an image sequence number to the item (image identification key), associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key as disclosed by Bellinger and use of

known image capturing tools and known database tools for keeping and manipulating records, to complement the microfilm check images and provide a digitally captured images of checks stored on readable medium for indexing and cross referencing which allows the customer to retrieve the items using personal computer.

Re. Claim 2, Vicknair discloses wherein the source key is comprised of a source sequence number, a source identifier and a source processing date [paragraph 8].

Re. Claim 3, Vicknair discloses wherein the source key is *stored* in an archive in a **non-volatile memory** in association with the EIP sequence number [paragraphs 10, 14, 42 – non-volatile memory is obvious, see digital archive which has to be non-volatile memory]. **Bellinger also discloses non-volatile memory [col.6 lines 43-49] to store data on CD-ROM more cost effectively.**

Re. Claim 4, Vicknair discloses wherein the image sequence number is *stored* in the archive in association with the EIP sequence number [paragraph 13].

Re. Claims 5-11, Bellinger further discloses wherein an image key is *stored* in the archive in association with the EIP sequence number and the image key is comprised of the image sequence number, a capture date and a capture cycle; wherein the image data is *stored* in an archive in **non-volatile memory** in association with the EIP sequence number; wherein the image data is

stored in an archive in association with the source key; wherein the image data is *stored* in an archive in association with the image sequence number; wherein the image data is *stored* in an archive in association with an image key; and wherein the image key is comprised of the image sequence number, a capture date and a capture cycle [Figures 20-22; col. 12 lines 10-20; col. 6 lines 43-49] and **non-volatile memory [col.6 lines 43-49 - to store data on CD-ROM more cost effectively]**. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Vicknair and include the above feature as disclosed by Bellinger to index the check information using image key and allow the user to retrieve the check information from database using image identification as a retrieval key and store the data no non-volatile memory such as CD-ROM cost effectively.

Re. Claim 12, Vicknair discloses for each of the items to which an EIP sequence number has been assigned, posting the item's transaction data to a posting system and associating the item's posted transaction data with the item's EIP sequence number [paragraphs 06-07].

Re. Claims 13-26, Bellinger further discloses for each of the items to which an EIP sequence number has been assigned, posting at least some of the item's transaction data to a posting system and associating the item's posted transaction data with the item's EIP sequence number [Figures 20-22 and associated descriptions; col. 2 lines 52-61; col. 13 line 55 through col. 14 line 26]; wherein the item's posted transaction data is *stored* in an archive in **non-volatile memory** in association with the item's EIP sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's source key; wherein the item's posted

transaction data is *stored* in an archive in association with the item's image sequence number; wherein the item's posted transaction data is *stored* in an archive in association with an image key; wherein the image key is comprised of the image sequence number, a capture date and a capture cycle; wherein the posting system is pre-existing (business choice); assigning a posting sequence number to each item posted; and associating the item's posting sequence number with the item's posted transaction data; wherein the item's posted transaction data is *stored* in **non-volatile memory** in an archive in association with the item's posting sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's EIP sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's source key; wherein the item's posted transaction data is *stored* in an archive in association with the item's image sequence number; wherein the item's posted transaction data is *stored* in an archive in association with an image key; and wherein the image key is comprised of the image sequence number, a capture date and a capture cycle [Figures 20-22; col. 12 lines 10-20; col. 3 lines 25-31; col. 4 lines 13-35] and **non-volatile memory** [col.6 lines 43-49 - to store data on CD-ROM more cost effectively]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Vicknair and include the above feature, as disclosed Bellinger by posing and storing of the items with image identification number crossed reference with EIP sequence number, account number, etc to make it possible for indexing the item with different keys/fields which may serve as an effective way to retrieve the item if only a limited information is known about the item.

Re. Claims 81, 153-156 are rejected with same rational as claim 1 (Vicknair in view of Bellinger).

Re. Claims 82-105, are rejected with same rational as claims 2-26.

Response to Arguments

1. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments filed have been fully considered but they are not persuasive:
3. In Response to applicant's remark recited in page 34 "The Examiner mistakenly interpreted Applicant's statement as a withdrawal of generic dependent claims 2-11 and 82-91 ..." The Examiner respectfully does not agree with attorney's statement. The Examiner points out to the Applicant's communication of 7/25/2008 first paragraph "Applicant hereby provisionally elects the species of Claims 12-26 and 92-105 ..." Also see Interview Summary dated 3/10/2009. The mistake is done by the Applicant not by the Examiner.
4. In response to applicant's comments that certain limitations are not disclosed by either the primary or secondary reference. The Examiner respectfully disagrees. Both primary and secondary references are in the field of applicant's invention. Applicant has failed to positively state why the disclosed elements by the primary or secondary references are not prior art or analogous to the current invention. It has been held that a prior art reference must either be in the

field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Also for duplication of parts or repeated task (such as: first time and second time) see *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Abdi Kambiz can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Primary Examiner, Art Unit 3692

6/16/2009